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EXAMINER

HUMPHREY, LOUISE WANG ZHIYING

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

This Office Action is in response to the amendment filed on 7 March 2008. Claims 1, 2, 4-29, 34-61, 66-92, 97-122 and 126-180 are cancelled. Claims 3, 30-33, 62-65, 93-96 and 123-125 are pending and currently examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The written description rejection of claims 3 and 96 under 35 U.S.C. §112, first paragraph, is **withdrawn** in response to Applicants' response.

The scope of enablement rejection of claims 3 and 96 under 35 U.S.C. §112, first paragraph, is **withdrawn** in response to Applicants' response.

Allowability Withdrawn

The indicated allowability of claims 30-33, 62-65, 93-95 and 123-125 is withdrawn in view of the newly discovered reference to US patent no. 7,273,716 B2. Rejections based on the newly cited reference follow.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151

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U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 3 is rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 2 of prior U.S. Patent No. 7,273,716 B2. The conflicting claims have identical scope of invention even though the phrase “peripheral blood mononuclear cell (PBMC) extract” is recited separately in a dependent claim in the U.S. Patent No. 7,273,716 B2. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3, 30-33, 62-65, 93-96, and 123-125 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over

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claims 2, 10 and 12-15 of U.S. Patent No. 7,273,716 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims 3, 30-33, 62-65, 93-96, and 123-125 are anticipated by the patented claims 2, 10 and 12-15. Both sets of claims have the same method steps. The instant claims fully encompass the claims of U.S. Patent No. 7,273,716 B2. For example, the instant claim limitation of "at least a partially purified fraction of PBMC extract comprising GS-7340 ester hydrolase activity, which has carboxylic ester hydrolase activity but does not cleave alpha-naphthyl acetate" is the same subject matter as the patent claim limitation of "a purified extract that comprises GS-7340 ester hydrolase" and the instant claim limitation of "a cell-free environment" encompasses the patent claim limitation of "in vitro."

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LOUISE HUMPHREY whose telephone number is (571)272-5543. The examiner can normally be reached on Mon-Thu, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. H./
Examiner, Art Unit 1648

/Bruce Campell/
Supervisory Patent Examiner, Art Unit 1648